



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/743,818	04/26/2001	Anthony Steven Weiss	GHC11USA	8602

270 7590 08/25/2003

HOWSON AND HOWSON
ONE SPRING HOUSE CORPORATION CENTER
BOX 457
321 NORRISTOWN ROAD
SPRING HOUSE, PA 19477

EXAMINER

SCHNIZER, HOLLY G

ART UNIT PAPER NUMBER

1653

DATE MAILED: 08/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/743,818	WEISS, ANTHONY STEVEN	
	Examiner	Art Unit	
	Holly Schnizer	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-89 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 46-89 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input checked="" type="checkbox"/> Other: <u>attachment of claims as numbered under Rule 126</u> |

DETAILED ACTION

Status of the Claims

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The misnumbered claims have been renumbered as indicated below:

Upon entry into the National Phase, Claims 1-44 were pending in this Application (Claims as amended, on July 24, 2000, during International examination).

The Preliminary Amendment filed January 16, 2001, canceling Claims 23-41 and claims 57-75 and 82-86, considered non-existent, has been entered. (Claims 1-22 and 43-44 pending).

The second Preliminary Amendment filed January 16, 2001 adding Claim 87 has been entered. Under Rule 126, misnumbered Claim 87 was renumbered as Claim 45. (Claims 1-22, 43-44, and 87(renumbered as 45) pending).

The third Preliminary Amendment ("Preliminary Amendment C") filed June 4, 2001, canceling claims 1-22, 42-44 and incorrectly numbered Claim 87(renumbered as Claim 45), and adding Claims 45-88, has been entered. Misnumbered Claims 45-88 have been renumbered as Claims 46-89, respectively. A copy of the claims as renumbered is attached to this Office Action.

Compliance with the Sequence Rules

The present Specification and claims contain numerous references to amino acid sequences without providing a sequence identifier. The following are the locations of some of the references to sequences without sequence identifiers: pp. 7-10, 12-13, 17-18, 24-25, 37-38, 42, 63 (Table I), Fig. 4 or p. 31 (brief description of the drawings) (No reference to identifier for nucleotide sequence), and Claims 49, 50, 58, 60, 70, 77, and 82-86. This list only represents an example of some of the references to sequences found by the examiner. Applicant is advised to thoroughly review and correct the entire specification for compliance with the sequence rules.

Where the description of a patent application discusses a sequence of 4 or more amino acids or 10 or more nucleic acids, reference must be made to the sequence by use of the sequence identifier preceded by "SEQ ID NO:" in the text of the description even if the sequence is also embedded in the text of the description of the patent application (see 37 C.F.R. 1.821, especially paragraphs (a)-(d)). The sequence identifier may be used in either the drawing or the Brief Description of Drawings (see MPEP 2429, helpful hint no. 21).

It is noted that correction of the Specification and Claims for compliance with the sequence rules is required for the response to this Restriction Requirement to be considered fully responsive.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 45-66, drawn to a method to reduce susceptibility of tropoelastin to protease digestion, classified in Class 435, Subclass 471.

Group II, claim(s) 67-81 and 87, drawn to a method of enhancing susceptibility of tropoelastin to protease digestion, classified in Class 435, Subclass 471.

Group III, claims 82-86 and 88, drawn to peptidomimetic molecules, classified in Class 530, Subclass 300.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Pursuant to 37 C.F.R. § 1.475(d), the ISA/US considers that where multiple products and processes are claimed, the main invention shall consist of the first invention of the category first mentioned in the claims and the first recited invention of each of the other categories related thereto. Accordingly, the main invention (Group I) comprises the first recited method, a method for reducing or eliminating protease susceptibility of a tropoelastin. Further pursuant to 37 C.F.R. § 1.475(d), the ISA/US considers that any feature which the subsequently recited products and methods share with the main invention does not constitute a special technical feature within the meaning of PCT Rule 13.2 and that each of such products and methods accordingly defines a separate invention.

The special technical feature of Group I is considered to be methods of reducing the susceptibility of tropoelastin to protease digestion.

The special technical feature of Group II is considered to be methods of enhancing the susceptibility of tropoelastin to protease digestion.

The special technical feature of Group III is considered to be peptidomimetic molecules that contain protease cleavage sites similar to those found in tropoelastin sequences.

Accordingly, Groups I-III are not so linked by the same or corresponding special technical feature as to form a single general inventive concept.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). In addition, as indicated above, a complete reply to this requirement also must include appropriate corrections for compliance with the sequence rules.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Holly Schnizer whose telephone number is (703) 305-3722. The examiner can normally be reached on Mondays through Wednesdays from 8:00 am to 5:30 pm

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The central official fax phone number is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Holly Schnizer
August 18, 2003



CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600